

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILLIP J. OLSON

Appeal No. 2001-1225
Application No. 09/019,693

ON BRIEF

Before ABRAMS, McQUADE and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a game played on a playing surface. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Seede	1,599,188	Sep. 7, 1926
Sterlicchi <u>et al.</u> (Sterlicchi)	3,647,215	Mar. 7, 1972
Schwartz	3,841,632	Oct. 15, 1974
Breslow	3,907,294	Sep. 23, 1975
Laciste	4,146,228	Mar. 27, 1979
Sexton	4,934,024	Jun. 19, 1990
Melton	4,962,929	Oct. 16, 1990
Chou <u>et al.</u> (Chou)	5,467,538	Nov. 21, 1995
Gay	5,882,007	Mar. 16, 1999

Claims 1-5, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seede in view of Breslow, Gay, Sterlicchi, Schwartz, Chou and Laciste.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references applied against claim 1 et al. further in view of Sexton.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references applied against claim 1 et al. further in view of Melton.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper

No. 13) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 9), the Supplemental Brief (Paper No. 12), the Response to Examiner's Answer (Paper No. 14), and the Supplemental Response (Paper No. 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The claims have been rejected under 35 U.S.C. § 103, and the guidance provided by our reviewing court for evaluating rejections under this section of the statute is as follows:

A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ

881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

As manifested in independent claim 1, the appellant's invention is directed to a competitive skill game comprising a playing surface having an upper end and two sides framed by an upstanding wall "and an unframed lower end which is open" and at which two playing stations are defined, a plurality of reboundable balls, a divider centered between the sides and extending from the unframed lower end substantially more than halfway toward the upper end, and a "paddle" for each playing station to launch balls and to return launched balls.

As we understand the examiner's rejection of claim 1, it is that Seede discloses all of the claimed subject matter except for the inclined playing surface and the plurality of balls. It is the examiner's view, however, that it would have been obvious to incline the

playing surface in view of the showing of Breslow and to provide extra balls to eliminate stoppage of the game to retrieve a lost, damaged or misplaced ball. To support the examiner's response to the appellant's challenge to the examiner taking Official Notice of the equivalence of pucks and balls as surface projectiles in games, the examiner has cited Sterlicchi, Schwartz, Chou and Laciste. The appellant has provided a number of arguments in opposition to the examiner's positions, which we find not to be persuasive with regard to claim 1. Our reasons for arriving at this conclusion follow.

In Figure 1, Seede discloses a competitive skill game played with a ball and comprising a playing surface having an upper end and two sides framed by an upstanding wall. The lower end is "unframed," as required by claim 1, in that there is no solid end, but a "yielding back stop 15" having a "pocket 16" into which a ball may expend its energy and then drop (page 2, lines 14-19). No solid support for the yielding back stop is described or shown. It is our opinion that the lower end of the Seede table is "unframed" and "open" to the same extent as the table disclosed by the appellant. In this regard, the table is described on page 6 of the appellant's specification as having a "blind pouch 30," which as shown in Figure 2 extends above the level of the table 12. Two playing stations are defined in the Seede device, which has a divider (5) centered between the sides and extending from the unframed lower end substantially more than halfway toward the upper end. Seede further discloses that the ball is to be struck by a mallet (page 1, lines 100-

104). With regard to this, the appellant argues that “a mallet having a flattened contact surface cannot be construed to correspond to a bowling pin shaped paddle” (Paper No. 14, page 5). However, this argument is not commensurate with the scope of claim 1, which does not require the bowling pin shape, and therefore, with regard to claim 1, it fails at the outset (see In re Self, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982)).

Insofar as the requirements of claim 1 are concerned, Seede fails to disclose or teach (1) that the playing surface be inclined, and (2) that there be a plurality of balls. Breslow discloses a competitive skill game comprising a walled playing surface upon which players located at two playing stations separated by a barrier cause a ball to move by striking it with a block-like implement. The playing surface is inclined upwardly from the playing stations, but the reference is silent as to the reason for this. However, it is our view that one of ordinary skill in the art would have found it obvious to incline the playing surface of Seede in the same fashion for the self-evident advantages thereof which would have been known by the artisan, such as increasing the speed of the ball in return from the upper end of the playing surface and insuring that it will roll back to the playing stations by gravity so that the game is continuous. We note here that skill is presumed on the part of the artisan, rather than the lack thereof (see In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)).

With regard to the requirement for a plurality of balls, we first focus on the fact that claim 1 is directed to a game and not to a method for playing a game. This being the case, from our perspective, one of ordinary skill in the art would have found it obvious to furnish more than one ball with the modified Seede game to provide the advantage of allowing the game to continue if the ball in play leaves the playing surface, or is damaged or lost (In re Sovish, supra). The prior art teachings relied upon need not disclose the same advantage that the appellant alleges, for all that is required is that there is a reasonable suggestion to combine the references (see In re Kronig, 539 F.2d 1300,1304, 190 USPQ 425, 427-28 (CCPA 1976) and Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985)). We view Sterlicchi, Schwartz, Chou and Laciste as merely being evidence that it was known at the time of the appellant's invention to provide more than one projectile for use in a table game.

For the reasons set forth above, it is our conclusion that the combined teachings of the applied references establish a prima facie case of obviousness with regard to the subject matter recited in claim 1. This being the case, we shall sustain the rejection of claim 1 and of claims 2, 3, 8 and 9, which the appellant has chosen to group therewith. In arriving at this conclusion, we have carefully considered the various arguments in rebuttal presented by the appellant. However, they have not convinced us that the rejection of these claims should not stand. Our position with regard to each of the arguments should

be apparent from the explanations we have offered in support of our conclusions. In addition, we regard the use of gloves by game-players to protect the hands to be an obvious expedient well within common knowledge and common sense of one of ordinary skill in the art (In re Bozek, supra). Finally, any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper (see In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)). We believe that to be the case here.

With regard to claim 4, the appellant points out that the examiner has cited no evidence for his conclusion that the claimed shape would have been a matter of design choice. It is asserted that when the paddle resembles the shape of a small bowling pin, as is recited in claim 4, "significantly greater numbers of potential interactions" with the ball are provided, which enhances the game, and therefore this feature cannot be attributed to design choice (see Paper No. 9, page 10). We are persuaded by this argument that a prima facie case of obviousness is lacking with regard to claim 4, and we will not sustain the rejection of claim 4 or of claim 5, which depends therefrom. The teachings of Sexton, which additionally were cited against claim 6, and those of Melton, added with regard to

claim 7, do not overcome the deficiency in the rejection of claim 4. We thus also will not sustain the rejection of claims 6 and 7, which depend from claim 4.

SUMMARY

The rejection of claims 1, 2, 3, 8 and 9 is sustained.

The rejection of claims 4, 5, 6 and 7 is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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APPEAL NO. 2001-1225 - JUDGE ABRAMS
APPLICATION NO. 09/019,963

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DECISION: **AFFIRMED-IN-PART**

Prepared By:

DRAFT TYPED: 02 May 02

FINAL TYPED: